

### REMARKS

This Amendment is submitted in response to the Office Action dated July 13, 2004. In the Office Action, the Patent Office rejected Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(b) as being unpatentable over *Fabel* (U.S. Patent No. 5,836,622). Additionally, the Patent Office rejected Claims 1-3, 8, 9 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Walz* (U.S. Patent No. 5,664,725) in view of *Schwan et al.* (U.S. Patent No. 5,524,934). Further, the Patent Office rejected Claims 4-6, 10, 12 and 24-26 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and further in view of *Petkovsek* (U.S. Patent No. 5,697,648). Applicant notes with appreciation that the Patent Office indicated that Claims 13-23 are in allowable form.

By the present amendment, Applicant amended Claims 1, 9 and 24-26. Applicant submits that the amendments to the claims overcome the rejections made by the Patent Office and place the application in condition for allowance. Notice to that effect is respectfully requested.

With respect to the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C §103(a) as being unpatentable over *Fabel*, Applicant submits that the rejection has been overcome in view of the foregoing amendments and the remarks that follow.

In the Office Action, the Patent Office alleges that:

*Fabel* discloses in Fig. 13, a mailing assembly and a method of preparing a mail piece comprising: a label

(72) having a front side (74) and a backside (75); and further wherein the label (72) includes shading and printing, wherein the shading and printing on the label are a single color (Col. 9, lines 26-33, wherein the information indicia is "printed in a green color"; and in Col. 10, lines 20-26, wherein the return receipt has a background color "using the same green ink used to pre-print information on sender's receipt section"). *Fabel* also discloses that the back sheet further comprises printed indicia on the outward portion of the back sheet (Col. 11, lines 14-20).

However, *Fabel* does not disclose wherein the back side of the label include shading and printing of a single color.

Contrary to the assertions of the Patent Office, independent Claim 1, as amended, requires a label having a front side and a backside opposite to the front side wherein the front side is juxtaposed to the backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the front side and the backside of the label include shading and printing wherein the shading and the printing are a single color and further wherein the single color is indicative of the special service.

Independent Claim 9, as amended, requires the step of providing a label having a front side and a backside opposite to the front side wherein the label includes a return postcard wherein the return postcard is a single layer. Further, Claim 9 requires the backside to include indicia and to abut the front side wherein the shading or the printing is indicative of the special service.

*Fabel* merely teaches a single form which provides various elements required for sending certified mail. As shown in Figure

13, *Fabel* teaches that the block 158 is located on the upper section 146 of the return receipt 86. Further, *Fabel* teaches that "the sender's address and the POSTNET code representing the ZIP code within the sender's address are printed in appropriate locations on lower section 144." (See *Fabel*, column 10, lines 51-54.) Still further, *Fabel* teaches that the return receipt 86 is "divided into a lower section 144 and an upper section 146 by a fold line 148." (See *Fabel*, column 10, lines 15-18.) Moreover, the Patent Office admits that "*Fabel* does not disclose the backside of the label which includes shading and printing of a single color."

Clearly, as the Patent Office admits, nowhere does *Fabel* teach or suggest a label which has a front side and a backside opposite to the front side wherein the front side is juxtaposed to the backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the front side and the backside of the label include shading and printing wherein the shading and the printing are a single color and further wherein the single color is indicative of the special service as required by Claim 1. Further, as the Patent Office admits, nowhere does *Fabel* teach or suggest a label having a front side and a backside opposite to the front side wherein the label includes a return postcard wherein the return postcard is a single layer wherein the backside which includes indicia and abuts

the front side wherein the shading or the printing is indicative of the special service as required by Claim 9.

The Patent Office admits that "*Fabel* also discloses that the back sheet further comprises printed indicia on the outward portion of the back sheet (Col. 11, lines 14-20)." Further, *Fabel* discloses that "generally, form 72 includes a front sheet 74 and a back sheet 75, each of which preferably has a thickness of a standard sheet of paper, about 0.003 inch." Still further, *Fabel* discloses that "sheets 74 and 75 are held together with an adhesive material 76 layer coated on the rear surface of front sheet 74." Moreover, *Fabel* discloses that "referring to FIG. 17, when return receipt 86 is folded into a postcard configuration, lower section 144 and rear section 146 of front sheet 74 become outer layers in an assembly having three layers, including a central layer formed by backing panel 174, with single adhesive material 76 layer between each of the paper layers."

Moreover, a person of ordinary skill in the art would never have been motivated to modify the teachings of *Fabel* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference in its entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention. A teaching, suggestion, or incentive must exist to make the modification made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

Even assuming that one having ordinary skill in the art could somehow have modified *Fabel* as applied by the Patent Office, *Fabel* still lacks the novel features and structural relationships and the novel steps positively recited in Claims 1 and 9, respectively. Namely, Clearly, as the Patent Office admits, *Fabel* does not teach or suggest a label which has a front side and a backside opposite to the front side wherein the front side is juxtaposed to the backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the front side and the backside of the label include shading and printing wherein the shading and the printing are a

single color and further wherein the single color is indicative of the special service as required by Claim 1. Further, as the Patent Office admits, *Fabel* does not teach or suggest a label having a front side and a backside opposite to the front side wherein the label includes a return postcard wherein the return postcard is a single layer wherein the backside which includes indicia and abuts the front side wherein the shading or the printing is indicative of the special service as required by Claim 9. Accordingly, the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 1-3, 8, 9 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.*, Applicant submits that this rejection has been overcome in view of the foregoing amendments and the remarks that follow.

In the Office Action, the Patent Office alleges:

*Walz* discloses in Fig. 1, 4 and 5, a mailing assembly comprising a label having a front side and a backside.

However, *Walz* does not disclose: a designator section indicative of a special service and has a machine readable code; and a label including shading and printing wherein the shading and printing are a single color.

*Schwan et al.* discloses in Fig. 2, 3 and 5, a record in the form of a label assembly (Col. 1, lines 10 and 11; and Col. 7, lines 14-16) having selected portions for forming areas of a plurality of different colors, wherein coatings of colorless color formers and developers are initially combined (upon application of an imaging force) to form colored visible areas (Fig. 3 and Fig. 4). The

coatings (color formers and color developers) can be applied in selection areas on the label, and when combined can form blocks of background color(s) or may be applied so as to form symbols or indicia (Col. 4, lines 58-61 and Claims 1-3), both in many different shades or hues (Col. 4, lines 14-20.)

As set forth above, independent Claim 1 requires a label having a front side and a backside opposite to the front side wherein the front side is juxtaposed to the backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the front side and the backside of the label include shading and printing wherein the shading and the printing are a single color and further wherein the single color is indicative of the special service. Independent Claim 9 requires the step of providing a label having a front side and a backside opposite to the front side wherein the label includes a return postcard wherein the return postcard is a single layer. Moreover, Claim 9 requires the backside to include indicia and to abut the front side wherein the shading or the printing is indicative of the special service.

Walz merely discloses a multi-part mailing form having two superimposed sheets of material wherein detachable areas of the upper sheet are detached and secured to an item to be mailed, and sections of the sheets are separable from one another. Contrary to the assertions of the Patent Office, *Schwan et al.* merely teach a sheet containing surface coatings of selected color formers and

color developers which, when subjected to heat or pressure, combine to form different colored areas on the sheet. Further, *Schwan et al.* merely teach that "the coating may be applied in selected areas which can form blocks of background color, or they may be applied so as to form images, symbols, stripes, borders, and the like." (See *Schwan et al.*, column 4, lines 57-60.) Still further, *Schwan et al.* teach that "both the colored areas and printed information on the record can be formed in a single printing pass." (See *Schwan et al.*, column 6, lines 2-4.)

Neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a label having a front side and a backside opposite to the front side wherein the front side is juxtaposed to the backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the front side and the backside of the label include shading and printing wherein the shading and the printing are a single color and further wherein the single color is indicative of the special service as required by Claim 1. Neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest the step of providing a label having a front side and a backside opposite to the front side wherein the label includes a return postcard wherein the return postcard is a single layer as required by Claim 9. Further, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a backside to



include indicia and to abut the front side wherein the shading or the printing is indicative of the special service as required by Claim 9.

The Patent Office admits that *Walz* does not disclose a label including shading and printing wherein the shading and printing are a single color. *Schwan et al.* merely teach that "the invention has the advantage that both information and the colored areas on the document may be achieved by printing in a single pass through a thermal or impact printer." (See *Schwan et al.*, column 7, lines 7-10.)

*Walz* merely discloses that "one of the marked areas on the outer face of one of the sheets comprising a designated addressee area for receiving the address to which the item is to be mailed and another of the areas on the outer face of the other sheet comprising a return address area for receiving the address of the sender of the item." Further, *Walz* discloses the "the form comprises two sheets of relatively thin sheet material such as paper stock or lightweight card stock such as a lightweight tag." Still further, *Walz* discloses that "upper sheet 12 and lower sheet 14 have an adhesive layer 16 between them for adhering the upper sheet to the lower sheet in certain areas, as best illustrated in FIGS. 2 and 3." Furthermore, *Walz* discloses that "by forming the return postcard of two sheets of paper which are bonded together,

it will have sufficient strength and thickness to meet Post Office requirements for return postcards in most cases."

Moreover, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Walz* with *Schwan et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Walz* and *Schwan et al.* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Walz* with *Schwan et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the references still lack the novel features and structural relationships and the novel steps positively recited in Claims 1 and 9, respectively. Namely, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a label having a front side and a backside opposite to the front side wherein the front side is juxtaposed to the backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the front side and the backside of the label include shading and printing wherein the shading and the printing are a single color and further wherein the single color is indicative of the special service as required by Claim 1. Further, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest the step of providing a label having a front side and a backside opposite to the front side wherein the label includes a return postcard wherein the return

postcard is a single layer as required by Claim 9. Moreover, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a backside to include indicia and to abut the front side wherein the shading or the printing is indicative of the special service as required by Claim 9. Accordingly, the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 4-6, 10, 12 and 24-26 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and further in view of *Petkovsek*, Applicant submits that this rejection has been overcome in view of the foregoing amendments and the remarks that follow.

In the Office Action, the Patent Office alleges:

*Walz* as modified *Schwan et al.* discloses a mailing assembly and method of preparing a mailpiece comprising all the elements as set forth in Claims 1 and 9, and as set forth above.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Walz's* and *Schwan et al.'s* mailing assembly with a printer track strip extension associated with the label as taught by *Petkovsek* for the purpose of allowing the mailing assembly to be passed through a printer.

Independent Claim 24, as amended, requires a label having a front side and a backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the return postcard is a single sheet and further wherein the label includes shading and printing wherein the

shading and the printing are a single color and wherein the assembly has a hole disposed therein. Independent Claim 25, as amended, requires a label which includes a return postcard wherein the return postcard is a single sheet wherein the label includes shading and printing wherein the shading and the printing are a single color. Independent Claim 26, as amended, requires the step of providing a label having a front side and a back side juxtaposed to the front side wherein the label includes shading and printing wherein the shading and the printing are a single color.

None of *Walz, Schwan et al.* or *Petkovsek*, taken singly or in combination, teach or suggest a label having a front side and a backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the return postcard is a single sheet and further wherein the label includes shading and printing wherein the shading and the printing are a single color and wherein the assembly has a hole disposed therein as required by Claim 24. Further, none of *Walz, Schwan et al.* or *Petkovsek*, taken singly or in combination, teach or suggest a label which includes a return postcard wherein the return postcard is a single sheet wherein the label includes shading and printing wherein the shading and the printing are a single color as required by Claim 25. Moreover, none of *Walz, Schwan et al.* or *Petkovsek*, taken singly or in combination, teach or suggest the step of providing a label having a front side and a

back side juxtaposed to the front side wherein the label includes shading and printing wherein the shading and the printing are a single color as required by Claim 26.

As set forth above, the Patent Office admits that *Walz* does not disclose a label including shading and printing wherein the shading and printing are a single color. *Schwan et al.* merely teach that "the invention has the advantage that both information and the colored areas on the document may be achieved by printing in a single pass through a thermal or impact printer." (See *Schwan et al.*, column 7, lines 7-10.) Further, *Walz* discloses that "the form comprises two sheets of relatively thin sheet material such as paper stock or lightweight card stock such as a lightweight tag." Still further, *Walz* discloses that "upper sheet 12 and lower sheet 14 have an adhesive layer 16 between them for adhering the upper sheet to the lower sheet in certain areas, as best illustrated in FIGS. 2 and 3." Furthermore, *Walz* discloses that "by forming the return postcard of two sheets of paper which are bonded together, it will have sufficient strength and thickness to meet Post Office requirements for return postcards in most cases."

Moreover, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Walz* with *Schwan et al.* and *Petkovsek* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art

would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Walz*, *Schwan et al.* and *Petkovsek* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Walz* with *Schwan et al.* and *Petkovsek* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the references still lack the novel features and structural relationships and the novel steps positively recited in Claims 24-26. Namely, none of *Walz*, *Schwan et al.* or *Petkovsek*, taken singly or in combination, teach or suggest a label having a front side and a backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the return postcard is a single sheet and further wherein the label includes shading and printing wherein the shading and the printing are a single color and wherein the assembly has a hole disposed therein as required by Claim 24. Further, none of *Walz*, *Schwan et al.* or *Petkovsek*, taken singly or in combination, teach or suggest a label which includes a return postcard wherein the return postcard is a single sheet wherein the label includes shading and printing wherein the shading and the printing are a single color as required by Claim 25. Moreover, none of *Walz*, *Schwan et al.* or *Petkovsek*, taken singly or in combination, teach or suggest the step of providing a label having a front side and a back side juxtaposed to the front side wherein the label includes shading and printing wherein the shading and the printing are a single color as required by Claim 26. Accordingly, the rejection of Claims 24-26 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.



Claims 2-8 depend from independent Claim 1; and Claims 10-12 depend from independent Claim 9. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements and novel steps of Applicant's novel assembly and method for preparing mailpieces, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Amendment; therefore, entry of this Amendment is proper and should be effected.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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I hereby certify that this **AMENDMENT AFTER FINAL** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 23, 2004.



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